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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,217	03/25/2004	Shoji Miyazaki	55220/844	6571

7590 01/18/2011
Craig J. Arnold, Esq.
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New York, NY 10016

EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT	PAPER NUMBER
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1759

MAIL DATE	DELIVERY MODE
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01/18/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/809,217	MIYAZAKI ET AL.	
	Examiner	Art Unit	
	ALEX NOGUEROLA	1759	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2010 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/889,243.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. In the Office action mailed on October 17, 2008 the Examiner made double patenting rejections based on U.S. Patent No. 6,875,327 B1 and separate provisional double patenting rejections based on then copending U.S. Patent Application No. 10/809,240. On February 02, 2009 Applicant submitted a terminal disclaimer against U.S. Patent No. 6,875,327 B1 and separately a terminal disclaimer against then copending U.S. Patent Application No. 10/809,240. Neither of these terminal disclaimers were approved because the signing attorney, Craig Arnold, was not of record. Applicant, in his Amendment received on July 06, 2009, page 7, attempted to resolve this problem by stating

In reply, applicants submit copies of Power of Attorney documents (4 pages) previously submitted in parent U.S. Patent Application No. 09/889,243, in which Craig J. Arnold is established as an attorney of record. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

The Examiner has learned that, unfortunately, in spite of Applicant's reply, a new terminal disclaimer is needed against U.S. Patent No. 6,875,327 B1 as is a new filing of power of attorney for Mr. Craig Arnold. As the Examiner does not review terminal

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disclaimers if Applicant has questions about this double patenting issue the Examiner suggests that Applicant contact Paul Urrutia at (571) 272-4919. No terminal disclaimer is needed against copending U.S. Patent Application No. 10/809,240 since this application was abandoned on November 25, 2009.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Double Patenting Rejections based on U.S. Patent No. 6,875,327 B1

3. Claims 45 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 10 of Miyazaki meets all of the limitations of claims 45 and 47 of the instant application. In particular, as for the second type of slits partly surrounding the dripped position, this is inherent since claim 10 requires the second type of slits to be around a position where the reagent is dropped. As for the second type of slits being in contact with the reagent, even if not stated to be so in claim 10 this is not excluded by claim 10 and moreover will very likely occur at least once the biosensor is used because the sample will dissolve the reagent so that it flows to the second type of slits. As for the second types of slits restricting the spread of the reagent, this will inherently occur since a slit in an otherwise flat surface will inherently raise the surface tension of liquid that flows onto it.

4. Claim 46 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 46 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because claim 11 of Miyazaki meets the additional limitation of claim 46 of the instant application.

5. Claim 49 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 3 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 49 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of Miyazaki meets the additional limitations of claim 49 of the instant application.

6. Claim 50 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 4 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 50 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of Miyazaki meets the additional limitations of claim 50 of the instant application.

7. Claim 51 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 5 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 47, from which claim 51 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 5 of Miyazaki meets the additional limitations of claim 51 of the instant application.

8. Claim 52 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 6 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 51, from which claim 52 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of Miyazaki meets the additional limitations of claim 52 of the instant application.

9. Claim 53 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 7 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 53 depends, has been addressed above. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because claim 7 of Miyazaki meets the additional limitations of claim 53 of the instant application.

10. Claim 54 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 8 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 53, from which claim 54 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 of Miyazaki meets the additional limitations of claim 54 of the instant application.

11. Claim 55 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 55 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of Miyazaki meets the additional limitations of claim 55 of the instant application.

12. Claim 56 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 12 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 56 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of Miyazaki meets the additional limitations of claim 56 of the instant application.

13. Claim 57 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 13 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 56, from which claim 57 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of Miyazaki meets the additional limitations of claim 57 of the instant application.

14. Claims 58 and 59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 14 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 58 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 14 of Miyazaki meets the additional limitations of claim 59 of the instant application.

15. Claim 60 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 14, 15, and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 60 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14 and 15 together of Miyazaki meet the additional limitations of claim 60 of the instant application.

16. Claim 61 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 14, 16, and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 60, from which claim 61 depends, has been addressed above. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because claim 16 of Miyazaki meets the additional limitations of claim 61 of the instant application.

17. Claim 62 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 18 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 62 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 18 of Miyazaki meets the additional limitations of claim 62 of the instant application.

18. Claim 63 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 19 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 63 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 19 of Miyazaki meets the additional limitations of claim 63 of the instant application.

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19. Claim 64 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 19 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 64 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 19 of Miyazaki meets the additional limitations of claim 64 of the instant application.

20. Claim 65 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 20 and 10 of U.S. Patent No. 6,875,327 B1 ("Miyazaki"). Claim 45, from which claim 65 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 20 of Miyazaki meets the additional limitations of claim 65 of the instant application.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXA NECKEL can be reached on (571) 272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alex Noguerola/
Primary Examiner, Art Unit 1759
January 14, 2011